

Remarks

The above Amendments and these Remarks are in reply to the Office Action mailed December 9, 2004 and the Examiner interview of February 8, 2005. The present reply is submitted with a Request for Continued Examination. Claims 1-61 were pending in the Application prior to the outstanding Office Action. In the Office Action, the Examiner rejected Claims 1-61. The present response amends claims 1, 11-13, 15, 17, 23, 29, 34, and 40. Claims 1-61 are now pending.

I. Summary of Examiner's Rejections

Claims 15-16 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement.

Claims 1-2, 4, 6, and 11-16 remain rejected under 35 U.S.C. 102(e) as being anticipated by Koppolu et al. (U.S. Patent No. 5,801,701), hereinafter Koppolu.

Claims 3, 5, 7-10, 17-25, 28-36, 39-40, 42-48, and 51 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Koppolu, in view of Vertelney et al. (U.S. Patent No. 5,341,293), hereinafter Vertelney.

Claims 26-27, 37-38, and 49-50 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Koppolu, in view of Vertelney, as applied to Claim 25, and further in view of Hoirup et al. (U.S. Patent No. 6,397,054), hereinafter Hoirup.

Claim 41 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Koppolu, in view of Vertelney, as applied to Claim 40 and further in view of Cohen et al. (U.S. Patent No. 6,324,543), hereinafter Cohen.

Claim 52 was rejected under 35 U.S.C. 103(a) as being unpatentable over Koppolu, in view of "Getting Results With Microsoft Office '97", hereinafter Office.

Claims 53-61 were rejected under 35 USC 103 (a) as being unpatentable over Koppolu in view of Vertelney.

2. Summary of Applicants' Response

Applicants traverse the 35 U.S.C. 112 rejections.

Applicants amend claims 1, 11-13, 15, 17, 23, 29, 34, and 40.

Applicants traverse the 35 U.S.C. 102 and 103 rejections.

3. Response to Rejections

A. **Claims 15-16 (112 Rejections)**

Claims 15-16 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement. The Examiner, in providing the rejection argued that element b of claim 15, which recites "an application interface layer configured to receive the document from the bit provider and provide the document to an application." cannot be located in the application.

Applicants direct the Examiner to the description of Figure 4 within the application. Specifically, lines 15-22 on page 21 disclose these features. This section states:

"In Fig. 4, the document management system 408 further includes a plurality of application interfaces in communication with applications 402a-402c for allowing document management system 408 to interface with applications 402a-402c.

These include word processor interface 416, e-mail interface 418, and web interface 420 in communication with the respective applications 402a-402c. The application interfaces 416, 418, and 420 are configured to receive documents from any of the bit providers 410, 412, and 414, and to provide the documents to the various applications”

The quoted section describes a plurality of interfaces (e.g. word processor interface, email interface, web interface) that receive documents from the bit provider and provide the documents to the various applications as per the claim. In light of the above, Applicants submit that claims 15 and 16 are enabled in the specification and request that the Examiner withdraw his rejection.

B. Claims 1-42 and 52-61

Independent claims 1, 11-13, 15, 17, 23, 29, 34, and 40 have been amended to recite one of the limitations of claims of claim 52, namely that the identification step is performed independent of a specific user request associating the data source and the associated property. Thus, these claims now recite variations of the following steps:

independent of a specific user request associating the associated property and the data source, identifying the data source as having the associated property;

retrieving the content information from the identified data source; and

providing the retrieved content information as at least a portion of the document

The art cited against claims 1-42 is deficient of any mention of an identification step performed independent of a specific user request. The independent claims within this group are

rejected over Koppolu and Koppolu in view of Vertelney. The section of Koppolu cited with regards to the identification step (i.e. Col. 1, ll 58-Col. 2, ll. 11) discloses a system whereby a document is copied manually to a clipboard and then loaded into a compound document in response to specific user requests. The document in Koppolu can only be constructed as a result of a direct user action to assemble the document from the constituent data sources. Vertelney also fails to disclose this feature. In light of the above, Applicants respectfully submit that claims 1-42, as amended, are patentably distinguishable over the prior art.

With regards to the rejection of claims 52-61, and the content of these rejections as they may apply to the newly amended claims 1-42, Applicants likewise traverse these rejections. The Examiner, in rejecting claims 52-61, cites Koppolu in view of Vertelney and Office, but applies a different interpretation of Koppolu. With regards to the sections of Koppolu cited in the Examiner's rejections of claims 52-61, Applicants submit that they also fail to disclose or suggest the claimed features.

The independent claims recite variations of providing the retrieved content information as at least a portion of the document. Koppolu is deficient of any mention of this feature. In his rejections of these claims, the Examiner defines "memory" as the data source and various menus and application functions as being the retrieved content that are provided as a portion of the document. However, menus, toolbars, and the like are not portions of a document. They are supplemental functions and graphics that are associated with a document, but not part of the document itself. They do not appear in the body of the document when it is viewed.

Additionally, the cited menus and toolbars are not modified through the normal document editing functions of the document editing tools and do not appear in printed versions of a document

or versions that are viewed in other applications. Additionally, their presentation and functionality is tied to the application presenting the document, rather than the document itself. Thus, Koppolu cannot reasonably be interpreted to disclose or suggest providing the retrieved content as a portion of the document. Vertelney and Office also fail to disclose or suggest this limitation.

With regards to the limitations of dependent claims 53-61, the Examiner references the previous rejections of the limitations of these dependent claims, but does not address any of the issues of how the prior art used in support of these rejections could be combined in light of the different interpretation of Koppolu. For example, claim 59 effectively recites that the data source is a phone, but the rejection does not address the incompatibility of drawing menu information for a spreadsheet from a phone. Similar problems exist with the rejections of other dependent claims within this group.

In light of the above, Applicants submit that claims 1-42 and 52-61 are patentably distinguishable over the prior art.

C. Claims 43-51

During the interview of February 8, 2005 the Examiner indicated that these claims were likely distinguishable over the cited art. In light of the above, Applicants request that the Examiner withdraw the rejection.

D. Note Regarding 103 Rejections

Finally, Applicants note that none of the Examiner's 103 rejections find any motivation to combine implicitly or explicitly within the cited references. The Examiner provides *benefits* for

adding these features, but such benefits are insufficient to render a claim obvious. *Any* feature having patentable utility is beneficial, however such a benefit is insufficient to render the addition of the feature obvious to one skilled in the art. The Federal Circuit has stated "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious *unless the prior art suggested the desirability of the modification*..... it is impermissible to use the claimed invention to piece together the prior art so that the claimed invention is rendered obvious". *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992).


E. Conclusion

The references cited by the Examiner but not relied upon have been reviewed, but are not believed to render the claims unpatentable, either singly or in combination.

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent. The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required

Respectfully submitted,

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